

Appln No. 09/923,829

Amdt date November 16, 2004

Reply to Office action of September 17, 2004

REMARKS/ARGUMENTS

Claims 1-22 are currently pending in this application. Claim 1 has been amended. The amendments find full support in the original specification, claims, and drawings, no new matter has been added. In view of the above amendments and remarks that follow, reconsideration, reexamination, and an early indication of allowance of claims 1-22 are respectfully requested.

Claims 1-6 are rejected under 35 U.S.C. 101 because the claimed invention is directed to a non-statutory subject matter. Applicant submits that the amendments made to claim 1 overcome this rejection. The amendments were made for reasons unrelated to patentability. Withdrawal of the rejection under 35 U.S.C. 101 is respectfully requested.

Claims 1-12 are rejected under 35 U.S.C. 102(e) as being anticipated by De Leo et al. (U.S. Patent No. 2003/0141360)<sup>1</sup>. Claims 13-22 are rejected under the same rationale as claims 1-12. Applicant respectfully traverses these rejections.

De Leo was filed on September 26, 2002 as a continuation-in-part (CIP) of U.S. Patent No. 6,567,842, which is a continuation of U.S. Patent No. 6,381,626 ('626 patent). The '626 patent was filed on April 22, 1999.

Applicant's application was filed on August 7, 2001. Thus, while the '626 patent antedates Applicant's application, any new matter added to the current De Leo CIP application does not, and

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<sup>1</sup> The Examiner makes reference to Grace in support of his rejection in paragraphs 6-11 of the Office Action. Applicant assumes that this is a typographical error, and that the Examiner intended to make a reference to De Leo.

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such new matter should be afforded the filing date of the CIP application, namely, September 26, 2002, which is after the filing date of Applicant's application.

In rejecting independent claims 1 and 7, the Examiner relied on the disclosure in paragraphs 0041, 0088-0092, 0099-0100, and 0114-0115 of the current De Leo CIP application. The disclosures in paragraphs 0088-0092, 0099-0100, and 0114-0115 do not appear in the '626 patent. Thus, De Leo's disclosure in paragraphs 0090-0091 that an ATM machine may be used to tailor advertisements to specific users, and that advertisements requiring user response may be used to dispense coupons by the ATM machine if the user reacts positively to the ad, do not appear in the '626 patent. Instead the disclosure in paragraphs 0088-0092, 0099-0100, and 0114-0115 were all added to the current De Leo CIP application. The disclosure in these paragraphs thus have a filing date of September 26, 2002, and should not be considered to be prior art material.

The only paragraph of the current De Leo CIP application relied on by the Examiner to reject claims 1 and 7 that does appear in the '626 patent is paragraph 0041. This paragraph, however, fails to teach or suggest all of the limitations of claims 1 and 7. Paragraph 0041 simply discloses configuration files which are used by the data terminals to control which message file is to be displayed to a terminal user, and the timing of such configuration files. Accordingly, claims 1 and 7 are in condition for allowance.

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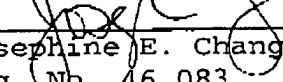
Claims 2-6 and 8-22 are also in condition for allowance because they depend on an allowable base claim, and for the additional limitations contained therein.

In view of the above amendments and remarks, Applicant respectfully requests reexamination, reconsideration, and an early indication for allowance of claims 1-22.

Applicant also requests that the Examiner acknowledge the references submitted along with an Information Disclosure Statement on June 18, 2004. Enclosed is a copy of the Information Disclosure Statement and PTO/SB/08A/B listing the references. It is respectfully requested that the Examiner return the forms to the Applicant after initialing the references, thereby indicating that they were expressly considered by the Examiner.

Respectfully submitted,

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626/795-9900

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Enclosures: Copy of Information Disclosure Statement  
Form PTO /SB/08A/B

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